APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,640	01/16/2001	G. Colby Conkwright	37865.010200	2254

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GREENBERG-TRAURIG
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EXAMINER
COLBERT, ELLA

ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *19 August 2003* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *20-23, 25-29 and 81* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *20-23, 25-29 and 81* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

1.   Claims 20-23, 25-29, and 81 are pending. Claims 20-23 and 25-29 have been amended and claim 81 has been added in this communication filed 08/19/03 entered as paper no. 16.

2.   The Objection to the Specification has been overcome by Applicants' amendment to the Specification and is hereby withdrawn.

3.   Claims 1-19, 24, and 30-80 should state they have been previously cancelled. Applicants' are requested to see the attached format to this Office Action for submitting amendments.

4.   The 35 U.S.C. 112 first paragraph rejection has been overcome by Applicants' amendment to the claims and is hereby withdrawn.

5.   The 35 U.S.C. 112 second paragraph rejection has been overcome by Applicants' amendment to claims 20-22 and is hereby withdrawn.

6.   The 35 U.S.C. 101 rejection for claims 20-23 and 25-29 has been overcome by Applicants' amendment to claims 20-23 and 25-29. However, as a preliminary matter the following is suggested in claim 20, the preamble and body: "A computer implemented method of correlating at least one dynamic dataset, ..., comprising the steps of: selecting at the computer at least on subset of said datasets ..." and claim 25, the preamble and body: "A computer implemented method of determining ..., comprising the steps of: selecting at the computer a subset of said datasets ...".

Claim Objections

7.   Claim 25 is objected to because of the following informalities: claim 25 recites

"selecting subset of said datasets ...". This claim should recite "selecting at least one

subset of said dataset ..." or "selecting a subset of said datasets ...".   Claim 26

recites "... dynamic data set corresponds to set-top box data. This claim should recite

"...dynamic data set corresponds to set-top box <u>event</u> data. Appropriate correction is

required.

Abstract

8.   The abstract of the disclosure is objected to because the Abstract is over 150

words in length. "A brief abstract of the technical disclosure in the specification must

commence on a separate sheet, preferably following the claims, under the heading

"Abstract" or "Abstract of the Disclosure". The abstract in an application filed under 35

U.S.C. 111 may not exceed 150 words in length. The purpose of the abstract is to

enable the United States Patent and Trademark Office and the public generally to

determine quickly from a cursory inspection the nature and gist of the technical

disclosure. The abstract will not be used for interpreting the scope of the claims."

MPEP 37CFR 1.172 (b). Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

9.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

10.   Claim 23 recites the limitation "... said demographic ... to determine the
relationship ... of demographics to content viewership" in lines 2 and 3. Claim 23
should recite the limitation "... said demographic <u>data</u>... to determine the relationship ...
of demographic <u>data</u> to content viewership." Claim 26 recites "... dynamic data set
corresponds to set-top box data. This claim should recite "...dynamic data set
corresponds to set-top box <u>event</u> data. Appropriate correction is required.
There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

12.   Claims 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable
over (US 6,216,129B1) Eldering in view of (US 6,463,585) Hendricks et al, hereafter
Hendricks and further in view of (US 5,842,199) Miller et al, hereafter Miller.

        With respect to claims 20 and 25, Eldering teaches, a method of correlating at
least one dynamic dataset, representing human behavior, and at least one static
dataset, wherein said dynamic and static datasets share at least one common
characteristic and have an assumed relationship, and using such correlations to
determine rule systems between the datasets, comprising the steps of: selecting at least
one subset of said datasets sharing at least one common characteristic (col. 8, lines 32-

42); expressing the assumed relationship between said static and dynamic datasets as a mathematical assumption (col. 8, lines 42-53 and col. 9, lines 26-38).

Eldering fails to teach, defining an error function which describes said static and dynamic datasets in terms of said mathematical assumption; performing at least one fitting procedure to calculate values that define said mathematical assumption; performing at least one fitting procedure to account for errors in the assumed relationship; and using the computer processor to store said mathematical assumption in a database as a rule system between said dynamic and static datasets.

Hendricks teaches, defining an error function which describes said static and dynamic datasets in terms of said mathematical assumption (col. 11, lines 44-50 and col. 36, lines 56-64); performing at least one fitting procedure to calculate values that define said mathematical assumption (col. 42, lines 29-62); and performing at least one fitting procedure to account for errors in the assumed relationship (col. 44, lines 8-65 and col. 45, lines 47-56).

Eldering and Hendricks fail to teach, using the computer processor to store said mathematical assumption in a database as a rule system between said dynamic and static datasets.

Miller teaches, using the computer processor to store said mathematical assumption in a database as a rule system between said dynamic and static datasets (col. 8, lines 47-67, col. 9, lines 1-9, and col. 12, lines 10-22). It would have been obvious to one having ordinary skill in the art at the time the invention was made to define an error function which describes the two datasets in terms of said mathematical

assumption; perform fitting procedures to account for errors in the assumed

relationship; perform fitting procedures which account for errors in the definition of the

common subsets and to use the computer processor to store said mathematical

assumption in a database as a rule system between said dynamic and static datasets to

modify in Eldering because such a modification would allow Eldering to analyze the

information and to use an algorithm to perform the mathematical assumption of the

datasets.

With respect to claim 25, Eldering teaches, using said processor to store said

mathematical assumption and said error function in an individual-specific array in a

database (col. 3, lines 3-28 –shows the correlations and col. 8, lines 1-12 shows the

storage).

Eldering fails to teach, repeating this process, such that a plurality of said

mathematical assumptions and said error functions are stored in said individual-specific

array.

Hendricks teaches, repeating this process, such that a plurality of said

mathematical assumptions and said error functions are stored in said individual-specific

array (col. 37, lines 11-67, col. 38, lines 1-66, and col. 39, lines 1-65). It would have

been obvious to one having ordinary skill in the art at the time the invention was made

to repeat this process, such that a plurality of said mathematical assumptions and said

error functions are stored in said individual-specific array and to modify in Eldering

because such a modification would allow Eldering to have an algorithm for repeating the

process steps of claim 25. Other algorithms can be used for assigning advertising to

groups of set top terminals or to individual terminals other than the algorithm described

in col. 37, line 11- col. 38, line 66, and col. 39, lines 1-65.

13.   Claims 21-23, 26-29, and 81 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Eldering in view of Hendricks et al, hereafter Hendricks in view of

(US 5,956,693) Geerlings and further in view of (US 6,055,491) Biliris et al, hereafter

Biliris.

With respect to claims 21 and 26, Eldering teaches, said dynamic dataset

corresponds to set-top box event data (col. 3, lines 6-12, col. 5, lines 9-26, col. 8, lines

1-17, and fig. 1A (106)).

With respect to claims 22 and 27, Eldering teaches, said static dataset

corresponds to demographic data (col. 12, lines 47-54).

With respect to claim 23, Eldering teaches, correlations are drawn between said

set-top box event data and said demographic to determine the relationship of

demographics to content viewership (col. 7, lines 4-67).

With respect to claim 28, Eldering and Hendricks fail to teach, said individual-

specific array corresponds to a privacy-compliant identification number.

Geerlings teaches, said individual-specific array corresponds to a privacy-

compliant identification number (col. 5, lines 58-67 –shows "customer NR" Number).

Eldering teaches, a set-top box identification number and a set-top box in col. 8, lines

13-31 and Fig. 1B (106). Hendricks teaches, a Group Assignment matrix including the

set top terminal identifier, Zip code+4 data in col. 13, lines 46-67, col. 14, lines 1-12, and

col. 29, lines 6-32. It would have been obvious to one having ordinary skill in the art to

have an individual-specific array correspond to a privacy-compliant identification

number and to modify in Eldering in view of Eldering's set-top box identification number

because such a combination would allow the set-top box to become privacy-compliant

in Eldering's system.

With respect to claim 29, Eldering, Hendricks, and Geerlings fail to teach, an

IDM solution used as a means for performing at least one of said fitting procedures.

However, Hendricks does teach, a Category/Group Definition Matrix and a Group

Assignment Matrix in col. 31, line 57 to col. 32, line 67, col. 33, 49-67, and col. 34, lines

19-39.

Biliris teaches, an IDM solution used as a means for performing at least one of

said fitting procedures (col. 3, lines 10-67 and col. 4, lines 1-41). It would have been

obvious to one having ordinary skill in the art at the time the invention was made to

have an IDM solution used as a means for performing at least one of fitting procedures

and to modify in Eldering because such a modification would allow Eldering to use an

inverse matrix algorithm to make a prediction and per sample to update the matrix.

Such examples that use an inverse matrix are currency exchange rates, network traffic

data from different network elements, demographic data from multiple jurisdictions,

patient data varying over time, and so on (see col. 1, lines 12-16 –Biliris reference).

With respect to claim 81, Eldering teaches, said privacy-compliant identification

number is a set-top box identification number (col. 8, lines 13-31 and fig. 1B(106)).

Response to Arguments

13.   Applicants' arguments with respect to claims 20-23 and 25-29 have been

considered but are not persuasive.

1.   Applicants' argue: Hendricks clearly does not teach or suggest defining an

error function which describes two datasets in terms of a mathematical assumption, as

recited in Applicants' Claims 20 and 25 has been considered but is not persuasive

because the Examiner interprets Hendricks as teaching defining an error function which

describes said static and dynamic datasets in terms of said mathematical assumption in

col. 11, lines 44-50 and col. 36, lines 56-64 –The interface regularly receives programs

watched information from billing sites, cable headends, or set top terminals. In addition,

other marketing information such as the demographics of viewers during certain time

periods may be received by the MII. The MII uses algorithms to analyze the program

watched ...". Col. 36, lines 56-64 –"... the algorithm can be modified ...". Table H

shows mathematical assumptions. Any mathematical assumption can be subject to

error.

2.   Applicants' argue: Hendricks clearly does not teach or suggest performing

fitting procedures to account for errors in the definition of common subsets has been

considered but it not persuasive because it is interpreted that Hendricks teaches an

error in col. 42, lines 33-42.

3.   Applicants' argue: It is well established that, in order to show obviousness,

all limitations must be taught or suggested by the prior art has been considered but is

not persuasive because the following is given in response to this argument: The

Examiner recognizes that obviousness can only be established by combining or

modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In conclusion: As to claim 1 and others above, in this rejection, for example, under Section 103 of Title 35 of United States code, the Examiner carefully drew up a correspondence between each of the Applicant's claimed limitations, one or more referenced passages in Eldering, Hendricks, Miller, Geerlings, and Biliris, what is well known in the art, and what is known to one having ordinary skill in the art at the time the invention was made. The Examiner is entitled to give the claim limitations their broadest reasonable interpretation in light of the Specification (see below):

2111   Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).<

Conclusion

14.   The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure.

Ludtke (US 6,202,210 B1) disclosed collecting data, consumer behavior, and marketing.

DuMouchel et al (US 6,539,391) disclosed unknowns as the least squares solution (col. 16, lines 38-40).

Gerace (US 5,848,396) disclosed viewing by regression analysis of responses of a set of users viewing advertisements.

Knee et al (WO 9960789 A1) disclosed an interactive television programming guide system used for determining user input values for demographic categories.

PHYS 251 –"Introduction to Computer Techniques in Physics" disclosed "best" fit known as Least Squares.

Gel, Yulia and Barabanov, Andrey disclosed Least Squares estimates for infinte AR models.

White, R.E.; Undergraduate Computational Engineering and Science-UCES: "Overdetermined Systems and Curve Fitting to Data" disclosed least squares method and normal questions on page 3, step 26 (curve fitting 1).

Gao, A.J. disclosed least squares algorithm and stochastic gradient algorithm.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

15.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

E. Colbert
October 30, 2003

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

MEMORANDUM

DATE: July 25, 2003

TO: Technology Center Directors

FROM: Stephen G. Kunin
Deputy Commissioner for Patent Examination Policy

SUBJECT: Revised Amendment Practice Final Rule Effective July 30, 2003

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 *Fed. Reg.* 38611 (June 30, 2003)), posted on the Office's website at: http://www.uspto.gov/web/patents/ifw/notices.html with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. The Office will notify applicants of preliminary and non-final amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). After-final amendments will be treated by examiners in advisory actions. The non-compliant section(s) of the amendment will have to be corrected and the entire corrected section(s) resubmitted within a set period.

The revised amendment practice is essentially the same as the amendment practice that the Office set forth in *AMENDMENTS IN A REVISED FORMAT NOW PERMITTED*, 1267 *Off. Gaz. Pat. Office* 106 (February 25, 2003) with some exceptions summarized here. The revised amendment practice, as distinguished from the voluntary revised amendment format, now: (1) requires the use of seven claim status identifiers (formerly eleven) including new identifiers "previously presented" and "not entered," (2) requires the inclusion of text for "withdrawn" claims and the exclusion of text for "not entered" claims in the complete listing of all claims, (3) mandates use of underlining and strikethrough for indicating changes to the specification and/or claims, (4) permits use of double brackets for the deletion of five or fewer characters or difficult to perceive text, and (5) provides for applicant's submission of, or examiner's requirement for, annotated drawing sheets in addition to the required replacement drawing sheets.

Amendments filed prior to July 30, 2003 in compliance with the previous version of 37 CFR 1.121 or the revised version promulgated in the Notice of Final Rule Making 68 *Fed. Reg.* 38611 (June 30, 2003) will be accepted. New informational flyers are being inserted with each out-going Office Action mailed during the period of June 2003 to August 2003. The flyer instructs applicants in the procedures to be used to comply with the revised practice for amendments to the claims, specification, and drawings. **A copy of the flyer is included herewith for your information.**

Further Assistance: Any questions regarding the submission of amendments pursuant to the revised practice should be directed to Office of Patent Legal Administration (OPLA) Legal Advisors, Elizabeth Dougherty (Elizabeth.Dougherty@uspto.gov), Gena Jones (Eugenia.Jones@uspto.gov) or Joe Narcavage (Joseph.Narcavage@uspto.gov). Alternately, you may send e-mail to patentpractice@uspto.gov, the OPLA e-mail address that has been established for receiving queries and questions about patent practice and procedures or telephone OPLA at 703.305.1616.

Attachment: Flyer – *Revised Amendment Practice: 37 CFR 1.121 Changed (Rev. 3, 7/24/03)*

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 *Fed. Reg.* 38611 (June 30, 2003), posted on the Office's website at: http://www.uspto.gov/web/patents/ifw/ with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period.

Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.
Note: The amendment practice for **reissues** and **reexamination** proceedings, except for drawings, has not changed.

REVISED AMENDMENT PRACTICE

I. Begin each section of an amendment document on a separate sheet:
Each section of an amendment document (*e.g.*, Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

II. Two versions of amended part(s) no longer required:
37 CFR 1.121 has been revised to **no longer require** two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for **substitute specifications** under 37 CFR 1.125 have been retained.

A) Amendments to the claims:
Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, **must include a complete listing of all claims** in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and the text of each pending claim (with markings to show <u>current</u> changes) must be presented. The claims in the listing will replace all prior claims in the application.

(1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), ***(previously presented) and (not entered).*** The text of all pending claims, ***including withdrawn claims,*** must be submitted each time any claim is amended. Canceled ***and not entered*** claims must be indicated by only the claim number and status, without presenting the text of the claims.

(2) The text of all claims <u>being currently amended</u> must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for ***deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change*** (e.g., ~~number 4 as~~ number 14 as). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.

(3) The text of pending claims <u>not being currently amended,</u> ***including withdrawn claims,*** must be presented in the claim listing in clean version, *i.e.*, without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims.

(4) A claim being canceled must be listed in the claim listing with the status identifier "canceled"; the text of the claim must not be presented. Providing an instruction to cancel is optional.

(5) Any claims added by amendment must be presented in the claim listing with the status identifier "(new)"; the text of the claim must <u>not</u> be underlined.

(6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled, or not entered, claims may be aggregated into one statement (*e.g.*, Claims 1 – 5 (canceled)).

<u>Example of listing of claims (use of the word "claim" before the claim number is optional):</u>

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a <u>plastic</u> grip.

Claim 9 (currently amended): A bucket with a ~~green~~ <u>blue</u> handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

B) <u>Amendments to the specification:</u>
Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for *<u>deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change (e.g., ~~number 4 as~~ number 14 as)</u>*

C) <u>Amendments to drawing figures:</u>
Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, *<u>and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations.</u>* Any replacement drawing sheet must *<u>be identified in the top margin as "Replacement Sheet"</u>* and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. *<u>Any marked-up (annotated) copy showing changes must be labeled "Annotated Marked-up Drawings" and accompany the replacement sheet in the amendment (e.g., as an appendix).</u>* The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to <u>patentpractice@uspto.gov</u> or by phone at (703) 305-1616.